

Application No.: 10/717,557

REMARKS

Claim 1 is independent and stands rejected under 35 U.S.C. § 112, first paragraph (written description). This rejection is respectfully traversed. Nonetheless, in order to expedite prosecution, the alleged new matter has been deleted rendering this rejection moot. Support for the newly added feature "causing contact resistance between the semiconductor and the transparent electrode to decrease" can be found, for example, on page 12, lines 10-12 of Applicants' specification.

As the Examiner has not provided any prior art rejection, it is respectfully submitted that the application is now in condition for allowance. Notwithstanding the "new matter" rejection, the Examiner was still required to issue prior art rejections if applicable, and the lack thereof indicates the patentability of the pending claims over prior art. The Examiner is directed to MPEP § 2163.06(I) under the heading Treatment of New Matter, "[t]he examiner should still consider the subject matter added to the claim in making rejections based on prior art since the new matter rejection may be overcome by applicant." In this regard, MPEP § 2163(III) states that

[r]egardless of the outcome of [the written description] determination, Office personnel must complete the patentability determination under all the relevant statutory provisions of title 35 of the U.S. Code. Once Office personnel have concluded analysis of the claimed invention under all the statutory provisions, including 35 U.S.C. 101, 112, 102, and 103, they should review all the proposed rejections and their bases to confirm their correctness. Only then should any rejection be imposed in an Office action. The Office action should clearly communicate the findings, conclusions, and reasons which support them.

Accordingly, as no prior art rejection has been made, it is respectfully submitted that the pending claims are patentable over the cited prior art.

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CONCLUSION

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication for which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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